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To: U.S. Patent and Trademark Office


From: Mr. Daniel J. Stanger, Reg. No. 32,846
MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C.

Re: USSN 09/940,982
Attorney Docket No.: NIT-295

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that the following listed documents are being facsimile transmitted to the U.S. Patent and Trademark Office on the date shown below:

Petition for Entry and Consideration of Preliminary Amendment
Filed November 24, 2006 (37 CFR 1.181)


Daniel J. Stanger
Reg. No. 32,846

March 7, 2007
Date

Total Number of Pages (including cover sheet): 5

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NIT-295

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: T. ENDO et al.
Serial No.: 09/940,982
Filed: August 29, 2001
For: TAMPER RESISTANCE DEVICE
Group: 2137
Examiner: Z. Davis

**PETITION FOR ENTRY AND CONSIDERATION OF PRELIMINARY
AMENDMENT FILED NOVEMBER 24, 2006 (37 CFR §1.181)**

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

March 5, 2007

Sir:

The Applicants respectfully petition for entry and consideration of the Preliminary Amendment filed on November 24, 2006, refusal of which was indicated by the Examiner in the outstanding Office Action mailed February 20, 2007.

On page 2 of the Office Action, the Examiner indicated as follows:

The supplemental amendment received on 24 November 2006 was not filed during a period of suspension of action as provided for in 37 CFR 1.111(a)(2)(ii) and is therefore not entered as a matter of right. Further, the supplemental amendment will not be entered because it adds new claims and therefore it is not clearly limited to the responses provided for by 37 CFR 1.111(a)(2)(i).

Respectfully, however, the Preliminary Amendment filed November 24, 2006 is not a "supplemental reply", the entry of which is provided for in 37 CFR §1.111(a)(2). That paragraph states, "A reply that is supplemental to a reply that is compliance with §1.111 (b) will not be entered as a matter of right except as

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provided in paragraph (a)(2)(ii) of this section." The "reply" is the reply mentioned in the title of 37 CFR §1.111, "Reply by applicant or patent owner to a non-final Office Action." The Preliminary Amendment filed November 24, 2006, by contrast, did not itself reply to any non-final Office Action and was not supplemental to a reply to a non-final Office Action. Indeed, the prior Preliminary Amendment filed November 8, 2006 (with a Request for Continued Examination (RCE)) is a "submission" required by 37 CFR 1.114, and not a "reply".

It appears, then, that the Preliminary Amendment filed November 24, 2006 is not specifically governed by any of the Rules under 37 CFR. However, the Applicants submit that the Preliminary Amendment in question (filed November 24, 2006) is more similar to a Preliminary Amendment filed after the filing of a new application than a Supplemental Reply to a reply to a non-final Office Action, entry of which is governed by 37 CFR 1.111.

The Preliminary Amendment on November 24, 2006 might therefore be entered and considered in accordance with the factors determining entry of a Preliminary Amendment after the filing date of a new application. That is, the Preliminary Amendment should be entered and considered so long as it does not "unduly interfer[e] with the preparation of a first Office action in an application." 37 CFR 1.115. As explained in the Manual of Patent Examining Procedure (MPEP) §714.01(e)(III)(B)(1), the factors that will be considered for denying entry of Preliminary Amendments under 37 CFR 1.115 include the state of preparation of a first Office Action as of the date of receipt of the Preliminary Amendment, and the nature of any changes to the specification or claims that would result from entry of the Preliminary Amendment. Continuing, this section of the MPEP notes that the entry of a Preliminary Amendment that would unduly interfere with the preparation of

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an Office Action may be denied if the Examiner has devoted a significant amount of time on the preparation of an Office Action before the amendment is received in the Office, and if the entry of the amendment would require significant additional time in the preparation of the Office Action. The MPEP gives an example in which the Examiner has spent a significant amount of time to conduct a prior art search or draft an Office Action before the Preliminary Amendment is received, and the Examiner would be required to spend significant additional time to conduct another prior art search or revise the Office Action.

Respectfully, in the present application, the Preliminary Amendment of November 24, 2006 was filed far in advance of the mailing date (February 20, 2007) of the present Office Action. The Applicants respectfully suggest that the Examiner does not seem to have devoted a significant amount of time to the preparation of the present Office Action before the November 24 date on which the Preliminary Amendment was received in the Office. Accordingly, the Applicants respectfully suggest that it does not seem that the Examiner required significant additional time to conduct another prior art search or revise the Office Action due to the November 24 Preliminary Amendment.

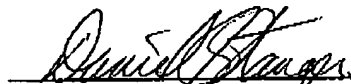
In conclusion, the Applicants respectfully submit that there is no practical reason why the Preliminary Amendment dated November 24, 2006 should not be entered and considered at this time, prior to the first Office Action on the merits after the filing of the RCE. Accordingly, the Applicants request entry and consideration of the Preliminary Amendment dated November 24, 2006, followed by a new Office Action with a reset statutory period for response.

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Inasmuch as the present Office Action has a running period for response, the Applicants request quick action on this request for consideration, and an early indication as to whether the request is granted.

Respectfully submitted,

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